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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,561	03/01/2002	Steven W. Lundberg	1551.002US1	2170

70859 7590 12/28/2007		EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 October 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-10,12-28 and 30-35</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-10,12-28 and 30-35</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date <u>20071008</u>.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1. Claims 11, 29, and 36 have been cancelled; therefore, Claims 1-10, 12-28, and 30-35 are

currently pending in application 10/087,561.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

3. **Claims 5-9** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the

written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

5. **Claim 4** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

6. Claim 4 recites the limitation "the seventh software component". There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> > (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. **Claims 1-10, 12-28 and 31-35 are rejected under 35 U.S.C. 102(e) as being anticipated**

by Grainger et al. (US 2002/0065677 A1).

9. As per **independent Claim 1**, Grainger discloses a system for managing information

disclosure statement (IDS) references, comprising: a computing system (Fig.1); a first

software component operable on the computing system to generate a plurality of IDS forms

(Fig.5, Para 0038-0039, completer and transmit IDS using IDS generation program); and a

second software component operable on the computing system to manage IDS references for

at least one organization (Fig.3 and 5, IDS storage); and a task managing software

component operable on the computing system to manage tasks within matters (Fig 13A –

task management system/method for specific cases/matters); and a database comprising IDS

references (Fig 8), wherein each organization only has access to its own IDS references (Para

0038, Documents stored in user database; Para 0079-0081, restricted access).

10. As per Claim 2, Grainger discloses a third software component operable on the computing system to provide a presentation for managing the IDS references associated with each matter of the at least one organization (Figs.13A-20).

11. As per Claim 3, Grainger discloses a fourth software component operable on the computing system to manage matters for the at least one organization; wherein the second software component is a part of the fourth software component (Fig.13A, Prior Art associated with Case).

12. As per Claim 4, Grainger discloses a fifth software component operable on the computing system to manage activities within matters; a sixth software component operable on the computing system to manage organizations; an eighth software component operable on the computing system to provide communications; and a ninth software component operable on the computing system to provide security; wherein the third, fourth, fifth, sixth, eighth, and ninth software components are capable of interfacing with the first and second software components in a patent prosecution enterprise application (Figs.13A-20).

13. As per Claim 5, as understood by the Examiner, Grainger discloses <u>wherein a first matter is related to a second matter within the organization by a criteria</u> (Figs.13A-20).

14. As per Claim 6, Grainger discloses <u>wherein the related matters are stored in a storage only accessible to the organization who owns the matters</u> (Para 0081, organizations maintain control of who access their IDS records through access codes).

15. As per Claim 7, Grainger discloses <u>wherein all the matters within the organization are classified</u> (Fig.3A).

16. As per Claim 8, Grainger discloses <u>wherein all the matters within the organization are</u>

<u>classified by status of a patent application, which is pending, issued, withdrawn, or</u>

<u>abandoned</u> (Figs.3A-3B).

17. As per Claim 9, Grainger discloses <u>wherein all the matters within the organization are</u>

<u>classified by type of patent application</u> (Figs.3A-3B).

18. As per **independent Claim 10**, Grainger discloses a method for <u>IDS</u> reporting, comprising:

receiving a report specification (Electronic File); interpreting the report specification;

generating an answer file (converting information format); receiving a plurality of

transformations to act on the answer file and an IDS form definition file; and providing an

IDS report (Para 0038-0039, Display in IDS form), <u>wherein the IDS report lists IDS</u>

<u>references, and the IDS references are only accessible to an organization who has ownership</u>

<u>thereof</u> (Para 0081, organizations maintain control of who access their IDS records through

access codes).

19. As per Claim 12, Grainger discloses receiving a question file; wherein interpreting the report

specification includes reading the question file (Para 0038).

20. As per **independent Claim 13**, Grainger discloses a method for managing information

disclosure statement (IDS) references, comprising: receiving a request to add an new

information disclosure statement (IDS) reference to a first matter (Fig.5) <u>owned by an</u>

<u>organization</u> (Para 0081, organizations maintain control of who access their IDS records

through access codes); searching <u>within the organization</u> for all matters related to the first

matter (Fig.5, Search for information); and adding the new IDS reference to selected matters

related to the first matter (Fig.5, Create form), <u>wherein the method manages the first matter</u>

and tasks within the first matter, and the new IDS reference is only accessible to the

organization who owns the first matter and the selected matters (Para 0081, organizations

maintain control of who access their IDS records through access codes).

21. As per Claim 14, Grainger discloses selecting only those matters related to the first matter

with a matter type that supports IDS reference management and only those matters having an

appropriate stage (Figs.13A-20).

22. As per Claim 15, Grainger discloses presenting a list of IDS references for a second matter,

wherein the second matter is related to the first matter; and indicating the new IDS reference

in the list originated in the first matter (Para 0008).

23. As per Claim 16, Grainger discloses indicating the new IDS reference is unmarked and

unreviewed (Fig.20)

24. As per **independent Claim 17**, Grainger discloses a system for managing information

disclosure statement (IDS) references, comprising: a computing system; a presentation layer

operable on the computing system to present an information disclosure statement (IDS)

reference inventory system; a business logic layer operable on the computing system to

manage the IDS reference inventory system and to generate IDS forms (IDS processing

system); and a data layer operable on the computing system to manage the data associated

with the IDS reference inventory system (Fig.11), wherein each organization only has access

to its own IDS references (Para 0081, organizations maintain control of who access their IDS

records through access codes).

25. As per Claim 18, Grainger discloses wherein the computing system comprises: a web server;

at least one browser in communication with the web server; and a file system accessible to

the web server; wherein the presentation layer, the business logic layer, and the data layer operate on the web server (Fig.11).

26. As per Claim 19, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; and a database management system accessible to the web server; wherein the presentation layer and the business logic layer operate on the web server and the data layer operates on the database management system (Fig.11).

27. As per Claim 20, Grainger discloses wherein the computing system comprises: a web server; at least one browser in communication with the web server; an application server in communication with the web server; and a database management system in communication with the application server; wherein the presentation layer operates on the web server, the business logic layer operates on the application server, and the data layer operates on the database management system (Fig.11).

28. As per **independent Claim 21**, Grainger discloses a computer-readable medium storing computer-executable instructions for performing a method, the method comprising: providing a presentation capable of associating at least one information disclosure statements (IDS) reference to at least one matter; and providing a presentation capable of listing each IDS reference associated with each matter (Figs.13A-20), and restricting access to IDS references so that each organization only has access to it own IDS references (Para 0079-0081, restricted access - organizations maintain control of who access their IDS records through access codes).).

29. As per Claim 22, Grainger discloses providing a presentation capable of generating an IDS form for at least one matter (Para 0038-0039).

30. As per Claim 23, Grainger discloses providing a presentation capable of modifying at least one IDS reference associated with at least one matter (Figs.13A-20).

31. As per Claim 24, Grainger discloses providing a presentation capable of deleting at least one IDS reference associated with at least one matter (Figs.13A-20).

32. As per Claim 25, Grainger discloses providing a presentation capable of searching all IDS references associated with one matter (Figs.13A-20).

33. As per Claim 26, Grainger discloses providing a presentation capable of searching all IDS references owned by one organization (Figs.13A-20).

34. As per Claim 27, Grainger discloses providing a presentation capable of marking at least one IDS reference associated with at least one matter (Figs.13A-20).

35. As per Claim 28, Grainger discloses providing a presentation capable of updating a review status of at least one IDS reference associated with at least one matter; and providing a presentation capable of showing the review status of each IDS reference associated with at least one matter (Fig.20)

36. As per Claim 31, Grainger discloses wherein presentation capabilities for each individual are determined based on their role in a matter and an organization associated with each individual (Para 0079-0081, Restricted Access).

37. As per Claim 32, Grainger discloses providing a presentation capable of uploading a stream of data associated with the at least one IDS reference (Para 0054, Activate Link/Pointer to IDS file).

38. As per Claim 33, Grainger discloses providing a presentation capable of downloading the

stream of data associated with the IDS reference (Para 0054, Attach Link/Pointer to IDS file).

39. As per Claim 34, Grainger discloses providing links for various applications capable of

opening and displaying the stream of data (Para 0054, Attach Link/Pointer to IDS file).

40. As per Claim 35, Grainger discloses providing a presentation capable of uploading a plurality

of streams of data associated with IDS references, the IDS references being associated with a

plurality of matters (Para 0054, Attach Link/Pointer to IDS file).

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the invention
> was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

42. **Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger in**

view of Official Notice.

43. As per Claim 30, Grainger fails to expressly disclose providing an accounting system to track

costs associated with storing IDS references.

44. However, one advantage to Grainger's system is the ability to manage costs involved with

handling IDS information (Para 0089). Furthermore, Official Notice is taken that the

accounting function was a well-known part of doing business when the invention was made,

for the purpose of tracking expenses and revenues of a company for owner/stockholder and

government/tax reasons (An Example of such Accounting Management can be found in "Cost Management: Accounting & Control" by Don R. Hansen and Maryanne M. Mowen, South-Western College/West; 4 edition, February 21, 2002). Finally, the database costs would be an obvious accounting element to track in such a database intensive system.

Response to Arguments

45. Applicant's arguments filed 10/8/2007, with respect to Claims 1-10, 12-28, and 30-35 have been considered but are not persuasive. The rejection will remain as FINAL, based on the sited prior art. Please see the Examiner's response to Applicant's arguments below and in the revised rejection above.

46. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

47. The Applicant has made the argument that the sited prior art fails to teach or disclose a second software component operable on the computing system to manage IDS references for at least one organization; wherein each organization only has access to its own IDS references.

48. However, Grainger teaches a system with an electronic IDS/electronic document storage
    component (Para 0038). Grainger also discloses controlling user access rights to the IDS
    information (Para 0081, organizations maintain control of who access their IDS records
    through access codes – could be other companies or no other companies the prior art covers
    both with the disclosed technology).

49. The Applicant has also made the argument that the sited prior art fails to teach or disclose a
    task managing software component operable on the computing system to manage tasks
    within matters

50. However, Grainger does disclose a system for managing tasks related to specific
    cases/matters (Fig.13A).

Conclusion

51. Any inquiry concerning this communication or earlier communications from the examiner
    should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The
    examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

52. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,
    John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization
    where this application or proceeding is assigned (571) 273-8300 for all official
    communications.

53. Any inquiry of a general nature or relating to the status of this application or proceeding
    should be directed to the Office of Initial Patent Examination whose telephone number is
    (703) 308-1202.

December 20, 2007

JONATHAN OUELLETTE
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600